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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/170,656	10/14/1998	SURESH JEYACHANDRAN	35.C13009	7028

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

LEE, TOMMY D

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 12/21/2001

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/170,656

Applicant(s)

JEYACHANDRAN ET AL.

Examiner

Thomas D. Lee

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 October 1998 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 23, 24, 32, 33 and 39-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23 and 32 each recite the limitation "said specific process" on line 4 of each claim. There is insufficient antecedent basis for this limitation in the claims.

Claims 22 and 31 each recite "a specific process", but claims 23 and 32 do not depend from claims 22 and 31, respectively. Claim 24 depends from claim 23, and claim 33 depends from claim 32.

Claims 39, 50 and 61 each recite the limitation "said notification *source*" (italics added) (claim 39, line 18; claim 50, line 17; claim 61, line 18). There is insufficient antecedent basis for this limitation in the claims. Claims 40-49 and 51-60 depend from claims 39 and 50, respectively.

In claim 45, the limitation "wherein said trigger for said notification is *an access effected by said access means*" is not entirely clear. It is believed that applicant is claiming an access means which effects the setting of the trigger recited in claim 39, but the examiner is unsure as to whether this interpretation is correct. Thus, this claim, as well as claim 56 which recites a similar limitation, is indefinite. Claims 46-48 and 57-59 depend from claims 45 and 56, respectively.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-39, 41-50 and 52-61 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,291,302 (Gordon et al.).

Regarding claims 1-19, Gordon et al. disclose an information processing apparatus comprising attribute designation means for designating an attribute (including at least one of an information name, an information transmitter name, and an information sender name) of object information (originating machine's identification, destination machine's telephone number stored, read column 7, lines 4-13); process designation means for designating a process (including at least one of reception, of transmission, and of printing) for said object information (fax message delivered to destination machine, read column 7, lines 15-20); setup means for setting up a

Art Unit: 2624

command (including a command for issuing a notification that said designated process has been completed; or a command for performing a further process, such as printing or holding said object information, related to said object information) to be executed ("delivery record" created upon successful delivery and sent back to the originating machine as a fax document, read column 9, lines 1-15); and execution means for executing said command set up by said setup means upon the performance of said process designated by said process designation means for said object information having said attribute designated by said attribute designation means ("transaction file" which includes delivery record is sent back to originating machine as a fax document, read column 9, lines 1-15). The information processing apparatus further comprises time limit setup means for setting a time limit; inhibition means for inhibiting said execution means for executing a command when said time limit set by said time limit setup means has expired (upon failure to deliver fax message within a time limit, a "retry record" is transmitted back to originator (column 10, lines 16-35), as opposed to the above-mentioned delivery record); status designation means for designating the status of said apparatus; and permission means for permitting said execution means to execute a command when said status designated by said status designation means is established (when the status of the apparatus allows for successful reception of fax message, a delivery record is created, as mentioned above); and management means for deleting a command set by said setup means when said time limit set by said time limit setup means has expired (message and report retransmitted back to originator, then erased, read column 10, lines 9-13). Accordingly, apparatus claims 1-9, as well as

Art Unit: 2624

corresponding method claims 10-18, are rejected. As for a storage medium which stores a program for performing the method steps as recited in claim 19, Gordon et al. provide software control as disclosed at column 19, beginning from line 22.

Regarding claims 20-38, Gordon et al. disclose an information processing apparatus comprising designation means for designating a status that is employed as an execution condition for a process to be performed (user has option of selecting "failed-connection message disposition" choice, read column 10, lines 3-5); setup means for setting up, together with said status, said process that is to be performed when said status designated by said designation means has occurred (menu of disposition options presented to user, read column 10, lines 5-8); determination means for determining whether said status designated by said designation means has occurred (failure in delivery of message to a destination detected, read column 9, lines 16-35); and execution means for, when the occurrence of said status is determined by said determination means, performing said process that is set up with said status (disposition option performed in accordance with selection by user, read column 10, lines 9-17). The information processing apparatus further comprises time period setup means for setting an effective time period; and inhibition means for inhibiting said execution means from executing a command at a time other than said time period set by said time period setup means (delivery of message not performed if user does not respond to choice within a time limit or after a suitable delay, read column 10, lines 9-17). Said designation means designates a status during which a specific process is to be performed (status being a failure in delivery of a message, and a specific process being

a process which is selected by a user, as mentioned above). At least one of reception, of the transmission, and of the printing can be designated as a type for said specific process (message may be resent to original destination or forwarded to another destination, read column 10, lines 14-17). At least one of a user name, of an apparatus, and of a process name can be designated as an attribute for said specific process (above-mentioned original destination and another destination are attributes for the disposition process). Said designation means designates a specific status for said apparatus, the specific status being a failure in delivery of the message, as mentioned above. The setup means is capable of setting, as said process to be executed, at least one of a notification, of a printing, and of a holding process (message may be retransmitted back to originator with a report, read column 10, lines 9-11). The information processing apparatus is capable of executing, at the least, either the reading or the printing of information (reports may be accumulated and delivered as a fax document, read column 10, lines 18-35). Accordingly, apparatus claims 20-28, as well as corresponding method claims 29-37, are rejected. As for a storage medium which stores a program for performing the method steps as recited in claim 38, Gordon et al. provide software control as disclosed at column 19, beginning from line 22.

Regarding claims 39, 41-50 and 52-61, Gordon et al. disclose an image processing apparatus comprising execution means for performing a process for object information to be processed, wherein said execution means transmits said object information (document image delivered to destination, read column 9, lines 1-5); notification destination designation means for designating a destination for a notification

Art Unit: 2624

related to said object information (delivery report sent back to originating machine, read column 9, lines 5-15); trigger setup means for setting a trigger for said notification; time setup means for setting a time period extending from the time at which said trigger for said notification is tripped until said notification is issued; and notification means for, when said time period that is set by said time setup means has elapsed since said trigger for said notification that is set by said trigger setup means has been tripped, issuing a notification to said notification source that is designated by said notification destination means, wherein a trigger for said notification is a successful conclusion or failure of the processing for said object information (predetermined time limit from success or failure in delivery of document to destination to sending of delivery record to originating machine, read column 9, lines 36-40; predetermined time limit indicates presence of trigger and time setup means). The information processing apparatus further comprises reception means for receiving object information to be processed; object information storage means for storing said object information received by said reception means; access means for accessing said object information stored in said object information storage means, effecting transmission and printing of object information at destination (incoming data stored in mass storage unit 67, read column 8, lines 12-15; data played back from storage and delivered to destination, read column 9, lines 1-5), or deletion of the object information (data erased from files after a suitable delay, read column 10, lines 9-13); and list display means for displaying a list of setup contents for a plurality of notifications (multiple reports delivered to originator, read column 12, lines 11-21). Accordingly, apparatus claims 39 and 41-49, as well as

corresponding method claims 50 and 52-60, are rejected. As for a storage medium which stores a program for performing the method steps as recited in claim 50, Gordon et al. provide software control as disclosed at column 19, beginning from line 22.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 40 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. as applied to claims 39 and 50 above, and further in view of U.S. Patent 6,144,462 (Kaplan).

Gordon et al. do not teach a notification medium selection step of selecting a notification medium related to said object information, wherein at said notification step a notification is issued using said notification medium selected at said notification medium

selection step, as recited in apparatus claim 40 and corresponding method claim 51.

Kaplan teaches a facsimile machine which provides the user with the option of specifying how a notification of the result of a fax communication is to be received (read Abstract). In view of Kaplan, it would have been clear to one of ordinary skill in the art that such a feature would provide the user with greater flexibility in receiving such notifications (read column 1, lines 15-50), and thus one of ordinary skill in the art would have been motivated to modify the teaching of Gordon et al. by providing a notification medium selection step such as taught by Kaplan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Application/Control Number: 09/170,656

Art Unit: 2624

Page 10



Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl

December 12, 2001